

**UNITED STATES PATENT AND TRADEMARK OFFICE**

Examiner: M Baye Diao      Docket No.: 3582      Art Unit: 2838

*In re:*

*Applicant:* Heiko ROEHM

*Serial No.:* 10/573,627

*Filed:* March 28, 2006

**A M E N D M E N T**

April 2, 2008

Commissioner for Patents  
P O Box 1450  
Alexandria, VA 22313-1450

Sir:

This communication is responsive to the Office Action January 16, 2008.

In the Office Action, claims 1-9 were rejected under 35 U.S.C. 103(a) over the U.S. patent application publication to Nottingham in view of the U.S. patent to Kilmer, et al and further in view of the U.S. patent to Chen.

Claims 8-14 were rejected under 35 U.S.C. 103(a) as claim 1 and further in view of the U.S. patent to Bennage.

After carefully considering the Examiner's grounds to the rejection of the claims over the art, applicant retained the claims as they were.

It is respectfully submitted that claim 1, the broadest claim on file, clearly and patentably distinguishes the present invention from the prior art applied by the Examiner.

Claim 1, the broadest claim on file, defines a battery-operated screwdriver, comprising the following elements:

a housing (12, 18) with a handle (14),  
in particular bent at an angle like a pistol grip,  
with a preferably fixedly installed rechargeable battery (40), and  
with charge contact tongues (37) for charging the battery (40) on a charger shell (22),

characterized in that the battery-operated screwdriver (10) has a battery (40),

which is designed as a lithium ion cell (Li ion cell) and can be placed on a charger shell (22), and the charging mode can be produced automatically;

and that the charger shell (22) comprises at least one detachably mounted bit holder (99) for storing tool inserts, particularly screwdriver bits, of the battery-operated screwdriver (10) in captive fashion.

The Examiner rejected the claims over the combination of the Nottingham, Kilmer and Chen references. The Examiner indicated that in his opinion the Nottingham reference disclosed a charger shell 22. Applicants have to respectfully disagree with this position for the following reasons.

Reference numeral 22 in the Nottingham publication refers to a trigger switch. The patent application publication to Nottingham discloses a battery powered screwdriver and a screw starting device which does not have any charger at all.

The patent to Kilmer discloses a portable battery operated power wrap tool. The power tool has a casing to which a battery pack is removably

mounted. Figure 8 clearly shows that the battery pack is removed from the power tool to be inserted into the charger.

Finally, the U.S. patent to Chen discloses a tool holder, which includes a main body with a compartment and a recess defined therein. A bit holding plate is removably received in the compartment of the main body and releasably holds at least one bit therein, as disclosed in the Abstract and in Figure 2 of this reference. It is believed to be clear that the Chen patent discloses a detachably mounted bit holder on a tool holder, but not on a charger. The patent to Chen does not disclose a charger at all. It is therefore believed to be clear that a person skilled in the art would not find any suggestion to arrange the detachably mounted bit holder on a charger.

The tool disclosed in the Nottingham reference when modified by the features of the tool disclosed in the patent to Kilmer as suggested by the Examiner would not only fail to include a charger shell which comprises at least one detachable mounted bit holder. The combination of the teachings of the references would also not show that the entire screwdriver is placed on the charger shell for charging the battery.

Furthermore the combination of the Nottingham, et al, Kilmer, et al, and Chen references as suggested by the Examiner would not give a reason,

suggestion or motivation to use a screwdriver with a charger shell having a detachably mounted bit holder. The combination would rather teach to provide a detachably mounted bit holder on the screwdriver itself, but not on the charger shell because the Chen reference provides a tool holder, i.e. a power tool in a certain sense, as can be seen from Figure 4 in which it is shown that a bit 50 is placed on the tool holder to be used as a manual screwdriver, with a detachably mounted bit holder.

It is therefore believed to be clear that the new features of the present invention which are defined in claim 1 are not disclosed in the references, and can not be derived from it as a matter of obviousness.

Claim 8 defines a charger cell for a battery-operated screwdriver defined in claim 1, which has the above analyzed new features. It is believed that the same arguments presented hereinabove are applicable to the charger cell defined in claim 8.

The patent to Bennage, et al discloses a fixedly attached bit holder on a power tool. The bit holder is formed by a recess area disposed on an enlarged handle base and one spring clip having an anchor end and retaining end. This reference does not teach a bit holder detachably mounted on a charger shell.

The combination of the Nottingham, Kilmer, Chen, and Bennage references would provide no hint, suggestion or motivation to provide a charger shell having a detachably mounted bit holder.

Claim 8 should also be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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